

Docket No.: 200111401-3 (1509-441)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	
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Christian S. SEIFERT	:	Confirmation No.: 1691
	:	
U.S. Patent Application No. 10/642,506	:	Group Art Unit: 2176
	:	
Filed: August 18, 2003	:	Examiner: Andrea Natae LONG
For: GRAPHICAL USER COMPUTER INTERFACE		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is submitted in reply to the Final Office Action mailed May 21, 2007.

Applicants respectfully request review of the final rejections of claims 1-5 and 7-24 as manifested in the Final Office Action. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal in compliance with *37 CFR 41.31* and the fee set forth in *37 CFR 41.20(b)(1)*.

The review is requested for the reasons stated on the attached sheets.

REASONS

The following clear errors are found in the Examiner's rejections.

1. The *35 U.S.C. 102(b)* rejection of independent claim 10 as being anticipated by *Rosenberg* is clearly erroneous, because the reference fails to teach or disclose each and every element of the rejected claim, e.g., "the menu item focus is moveable within the menu by means of the pointing device without moving the pointer," as argued in the March 7, 2007 Amendment, at page 10, line 10 from bottom through page 11, line 2 from bottom. The previous argument is hereby incorporated by reference herein for the panel's review.

The Examiner's response ¹ to Applicants' previous argument is noted. Applicants respectfully disagree with the Examiner for the following reasons.

With respect to the Examiner's argument that the prior art "does not eliminate the alternative function of the mouse wheel to only control the highlighter, without moving the pointer,"² Applicants respectfully submit that such argument is not proper under *35 U.S.C. 102* which requires that "the reference must teach every element of the claim" either explicitly or implicitly.³ "Does not eliminate" does not meet the anticipatory standard under *35 U.S.C. 102*.

In addition, the reference does not explicitly teach the claim limitation. Rather, the reference explicitly teaches the opposite arrangement, i.e., the wheel moves the pointer/cursor, as argued in the March 7, 2007 Amendment at page 10, line 10 from bottom through page 11, line 2 from bottom.⁴

The Examiner has also failed to prove that the reference discloses the claim limitation through inherency by providing "a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."⁵ The Examiner's analysis ⁶ of the reference's teachings proves, if at all, only that the movement of the wheel can be independent of the mouse. The Examiner's analysis, however, has failed to prove that the movement of the pointer/cursor can be independent of the wheel (and hence, the cursor can be fixed while the wheel moves) which is deemed necessary for a showing of inherency of the claim limitation.

¹ See, May 21, 2007 Final Office Action at pages 11-14.

² See, May 21, 2007 Final Office Action at page 11, lines 8-10 from bottom.

³ See, *MPEP*, section 2131.

⁴ See, also *Rosenberg* at column 17 line 34, column 20 lines 5-6 and 8-9.

⁵ *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

⁶ See, May 21, 2007 Final Office Action at page 11, lines 1-8 from bottom.

Accordingly, Applicants respectfully submit that *Rosenberg* does not anticipate the invention of claim 10, and request that the rejection of claim 10 be withdrawn.

2. The 35 U.S.C. 102(b) rejection of independent claims 18, 20 and 22 as being anticipated by *Rosenberg* is clearly erroneous at least for the reasons advanced with respect to claim 10, because the claims include limitations similar to the limitation of claim 10 argued above.

The rejection of claims 20 and 22 is also clearly erroneous because the reference fails to teach or disclose each and every element of the rejected claims as argued in the March 7, 2007 Amendment, at page 13, the second full paragraph and page 14, the second full paragraph. The previous arguments are hereby incorporated by reference herein for the panel's review.

3. The 35 U.S.C. 102(b) rejection of independent claim 21 as being anticipated by *Rosenberg* is clearly erroneous, because the reference fails to teach or disclose each and every element of the rejected claim, e.g., "activating, when the menu is opened, the one-dimension actuator to control movement of the menu item focus within the menu, while enabling the two-dimension actuator to control movements of both the menu item focus and the pointer within the menu," as argued in the March 7, 2007 Amendment, at the paragraph bridging pages 13-14. The previous argument is hereby incorporated by reference herein for the panel's review.

The Examiner's response ⁷ to Applicants' previous argument is noted. Applicants respectfully disagree with the Examiner for the following reasons.

The Examiner's allegation ⁸ that "*Rosenberg* further states that the mouse can control the cursor for selection of a menu item" is inaccurate. A menu item is selectable when the menu is opened. In *Rosenberg*, when the menu is opened, the mouse is disabled and it is the wheel that has exclusive control of the cursor's position.⁹

The Examiner's subsequent analysis of *Rosenberg*'s column 19 line 45 through column 20 line 24 is not on point. It should be noted that the claim language requires that the two-dimension actuator be enabled when the menu is opened to control movements of both the menu item focus and the pointer within the menu. In the Examiner's cited passage, the mouse apparently regarded by the Examiner as the claimed two-dimension actuator¹⁰ is disabled. No where in the reference does *Rosenberg* teach or disclose that, when the menu is opened, the mouse is enabled to control both the highlighter and the cursor within the menu as presently claimed.

⁷ See, May 21, 2007 Final Office Action at page 12, the last two paragraphs.

⁸ See, May 21, 2007 Final Office Action at page 12, line 4 from bottom.

⁹ See, *Rosenberg* at, e.g., column 20 lines 5-6 and 8-9.

Accordingly, Applicants respectfully submit that *Rosenberg* does not anticipate the invention of claim 21, and request that the rejection of claim 21 be withdrawn.

4. The rejections of the dependent claims are clearly erroneous at least for the reasons advanced with respect to the respective independent claims.

The 35 U.S.C. 103(a) rejection of claim 24 as being obvious over *Rosenberg* is clearly erroneous, for the further reason that the reference fails to teach or suggest the claim feature that “the menu closing item is positioned within the menu at a place unreachable by the one-dimension actuator,” as argued in the March 7, 2007 Amendment, at page 14, the first full paragraph. The previous argument is hereby incorporated by reference herein for the panel’s review.

The Examiner’s response ¹¹ to Applicants’ previous argument is noted. Applicants respectfully disagree with the Examiner for the following reasons.

The Examiner’s allegation ¹² that “*Rosenberg* teaches that the menu is closed by selecting a menu closing item within the menu with the one-dimension or two-dimension actuator” is inaccurate. As discussed above with respect to claim 21, in *Rosenberg*, when the menu is opened, the mouse (two-dimension actuator) is disabled.¹³ Therefore, any menu closing item of *Rosenberg* can only be selected by the wheel (one-dimension actuator). Thus, a person of ordinary skill in the art would not have been motivated to have placed such menu closing item at a position unreachable by the wheel, as presently claimed, because the menu closing item so placed would be redundant, unusable and useless.

The Examiner, in the subsequent section,¹⁴ appears to argue that a menu closing item is unreachable by the wheel if the wheel (one-dimension actuator) is not provided. The Examiner’s argument should fall, because the *Rosenberg* device/method, lacking a wheel (one-dimension actuator), would fail to meet the requirement of claim 21 (from which claim 24 depends) that an one-dimension actuator be activated (and hence, present) when the menu is opened.

Accordingly, Applicants respectfully submit that *Rosenberg* does not render obvious the invention of claim 24, and request that the rejection of claim 24 be withdrawn.

Withdrawal of the final rejections of claims 1-5 and 7-24 in view of the above is believed appropriate and therefore respectfully requested.

¹⁰ See, for example, May 21, 2007 Final Office Action at page 8, line 4.

¹¹ See, May 21, 2007 Final Office Action at page 10, the first full paragraph and page 14, the first two paragraphs.

¹² See, May 21, 2007 Final Office Action at, e.g., page 14, lines 3-5.

¹³ See, *Rosenberg* at, e.g., column 20 lines 5-6 and 8-9.

¹⁴ See, May 21, 2007 Final Office Action at, e.g., page 14, lines 6-10.

Application No. 10/642,406

Docket No.: 200111401-3 (1509-441)

To the extent necessary, a petition for an extension of time under *37 C.F.R. 1.136* is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 08-2025 and please credit any excess fees to such deposit account.

Respectfully submitted,
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